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| 08/925,868 | 09/09/97 | ISBARA M | INPA:035 |

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WILLIAM W. KIDD
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES CA 90025

| EXAMINER | |
|---|---|
| WELLS,K | |
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UNITED STATES DEPARTMENT OF COMMERCE
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**BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Paper No. 33

Application Number: 08/925,868
Filing Date: 9/9/97
Appellant(s): Isbara



Paul Mendonsa
For Appellant

## EXAMINER'S ANSWER

1. This is in response to appellant's brief on appeal filed on 1/16/01.

### REAL PARTY IN INTEREST

2. A statement identifying the real party in interest is contained in the brief.

### RELATED APPEALS AND INTERFERENCES

3. A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

## STATUS OF THE CLAIMS

4. The statement of the status of the claims contained in the brief is correct.

## STATUS OF AMENDMENTS AFTER FINAL

5. The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

## SUMMARY OF THE INVENTION

6. The summary of invention contained in the brief is correct.

## ISSUES

7. The appellant's statement of the issues in the brief is correct.

## GROUPING OF THE CLAIMS

8. Appellant's brief includes a statement that claims 1-17, 19 and 20 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

## APPEALED CLAIMS

9. The copy of the appealed claims contained in the Appendix to the brief is correct.

## PRIOR ART

10. The following is a listing of the prior art of record relied upon in the rejection of the claims under appeal.

| | | |
|---|---|---|
| 6,111,434 | CIRAULA ET AL | 8-2000 |
| 5,604,364 | OHMI ET AL | 2-1997 |
| 5,130,571 | CARROLL | 7-1992 |
| 4,970,478 | TOWNLEY | 11-1990 |
| 4,507,618 | NELSON | 3-1985 |

## GROUNDS OF REJECTION

11. Claims 1-17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson.

As to claim 1, note that Nelson discloses an RC attenuator, which is essentially all that appellant is reciting in this claim. The difference between claim 1 and Nelson is that appellant uses a continuously-on biased FET instead of the discrete resistor shown by each of the references. However, the

replacement of a discrete resistor with a continuously-on biased FET is notoriously well-known in the art (official notice is taken) and there is obvious motivation to make such a replacement, i.e., to save chip real estate, since discrete resistors take up more space than integrated FETs acting as resistance elements. The resistor recited in the claim also fails to distinguish patentably over Nelson because it is also old and well-known in the art to add such a series resistor between the gate bias voltage and the gate of the FET for the purpose of controlling the on level of the FET (and thereby controlling the resistance value of the FET), which is an old and well-known concept to those having ordinary skill in the art. The limitations that the input and output signals are binary does not define patentably over the applied prior art because, as appellant is well aware, the type of signals that are received and output by a certain device are not part of the device (i.e., they are not structural features of the invention) and thus are merely intended use limitations which cannot distinguish a claimed structure from a prior art structure which fully meets the claim under 35 USC 102 or 103. Moreover, note that the Nelson reference suggests using binary input and output signals (see Fig. 2 of that reference). The recitation of the levels of

the input or output signals cannot serve to distinguish over Nelson because these signals are not part of the invention, i.e., they are merely intended use limitations.

As to the remaining claims which recite the half-latch (i.e., the "buffer circuit" in claims 2-5, for example) including inverter 26 and pull-up FET 28, the limitations recited therein are also considered to be well-within the ordinary skill level since the use of a half-latch for reliably switching the signal at a node (or boosting/lowering the voltage) is notoriously well-known in the art as well, and thus these claims do not define over Nelson either.

Also note the references cited on the attached PTO-892 which show the equivalence of a discrete resistor and a continuously-biased FET (as disclosed by Carroll, Figs. 1 and 2; Townley, Figs. 3-6; and Ohmi et al, Fig. 9), and the references which show examples of the well-known half-latch (appellant's recited "buffer circuit"), as disclosed by Ciraula et al in Fig. 2 and Storino et al in Fig. 2.

RESPONSE TO ARGUMENTS

12. The first argument is that the cited prior art and the claimed invention are not "structurally similar." This argument is not persuasive because the resistor/capacitor parallel combination of Nelson is an *equivalent structure* to appellant's constantly-biased FET/capacitor parallel combination (as noted in the rejection above). Two circuits that are structural equivalents can certainly be considered to be structurally similar.

The next argument is that the "Examiner asserts that the Applicant may not argue functional differences when the prior art shows the identical structure." This argument is also without merit because nowhere did the examiner make such an assertion.

The next argument is that the "RC attenuator [of Nelson] has different structure than the claimed circuit." This argument is without merit because the rejection is under 35 USC 103 which, by definition, is to be used in rejections where there are one or more differences in structure between what is claimed and what is disclosed by a reference. Thus, to argue that a 103 rejection is improper because there are differences between what is disclosed by the prior art and what is recited in the claim(s) makes no sense.

The next argument is that "the structural differences (e.g. use of the biased transistor) arise from the intended use" of the claimed invention (emphasis in original). This argument also makes no sense. Structural differences clearly cannot "arise from" an intended use of an invention.

The next argument is that the RC attenuator of Nelson "is incapable of performing the intended use, namely, to provide level shifting of a binary signal by way of a pumping action as provided by the biased transistor." This argument is also without merit because it ignores the entire basis of the rejection, i.e., the rejection is under 35 USC 103, where the examiner has provided a reference which shows that the claimed structure would have been obvious to one of ordinary skill in the art (note the rejection above), and thus any resulting effect of the claimed structure will of course be present once the obvious modification of Nelson's Fig. 5 is made. Any argument that relies on "resulting effects" differences will necessarily fail when the *exact claimed structure* would have been obvious to one of ordinary skill in the art (which, as noted above, it would have been).

The next argument is that the "claimed circuit comprises both a different function (e.g. pumping), and structural

differences (e.g. the use of a biased transistor) arising from what the Examiner asserts is an intended use (the couplings to particular signal sources and sinks) (emphasis in original). This argument is also without merit for exactly the same reasons noted in the preceding paragraph.

The final argument is that the rejection of the method claims 15 and 16 is improper because "it is inappropriate to rely upon" intended use doctrine. This argument is also without merit because the preamble recitation in claim method 15 is an intended use (i.e., purpose) which is "generally not accorded patentable weight" as stated in MPEP 2111.02. The assertion that appellant's invention involves a novel use of the (obvious) claimed structure is without merit because the reference clearly teaches the same use (i.e., purpose, intended use) as claimed by appellant. The statement that "the process claims are not specific to the structure of the apparatus claims, but rather stand on their own functional limitations" is not understood.

CONCLUSION

13. For all the foregoing reasons, it is respectfully submitted that the rejection under 35 USC 103 is proper and therefore should be sustained.

Respectfully submitted,

Kenneth B. Wells
Primary Examiner
Art Unit 2816

Appeal conferees:

Arthur T. Grimley, SPE Art Unit 2852

Robert Pascal, SPE Art Unit 2817

June 26, 2001